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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78424189
Applicant	Crosswalk, Inc.
Applied for Mark	CROSSWALK
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In Re the Application of:)
)
Applicant: Crosswalk, Inc.)
)
Mark: CROSSWALK)
)
Serial No.: 78/424,189)
)
Filed: May 24, 2004)
)
_____)

REPLY BRIEF

Applicant Crosswalk, Inc. (“Applicant”), hereby offers this brief in reply to the Examining Attorney’s (or “Examiner”) brief on appeal (“Examiner’s Brief”).

I. INTRODUCTION

Applicant respectfully submits that the Examiner’s Brief offers no credible support for the position that Applicant’s CROSSWALK mark (the “Mark”) is likely to cause confusion with the marks shown in Registration No. 2,736,979 and Registration No. 2,805,119 (the “Cited Marks”) registered by Caron Broadcasting, Inc. (assigned by Crosswalk.com, Inc.) (“Registrant”). Instead, Applicant submits that the Examiner merely rehashes arguments and restates assertions from the First Office Action, which Applicant has already effectively discredited and revealed as inaccurate in its appeal brief (“Applicant’s Brief”). As such, Applicant maintains that it has established that the Mark is not likely to cause confusion with the Cited Marks and is appropriate for registration on the Principal Register.

II. ARGUMENT

Instead of simply repeating the arguments in Applicant's Brief that support the approval of Applicant's Mark for registration and remain unrefuted by the Examiner, Applicant will address the most glaring errors and omissions the Examiner presents in her Brief.

- The Examiner continues to miss the point of the relevance of the different connotations of Applicant's Mark and the Cited Marks.
 - The Examiner does not appear to understand that the services Applicant offers, as described in its application, are completely different from those offered by the Registrant in the Cited Marks.
 - The Examiner incorrectly analyzes the trade channels for the services covered by the subject marks.
 - The Examiner fails to acknowledge appropriately the sophistication of the potential purchasers of Applicant's services, an important factor under the relevant legal precedent.
- A. APPLICANT'S MARK AND THE CITED MARKS HAVE DIFFERENT CONNOTATIONS

The Examiner's Brief notes Applicant's point that Applicant's Mark and the Cited Marks have different connotations, but fails to address the issue, inexplicably restating rote (and inapplicable) language regarding the ability of an owner of a standard character mark to use the mark in any chosen font or style. That boilerplate is simply irrelevant to Applicant's argument. Applicant's point is that the commercial impression of the Cited Marks' term "crosswalk" is a pun on the traditional definition of a street crossing, and a religious "cross" walk (impliedly relating to Jesus' walk with his cross in Jerusalem). In contrast, Applicant's mark is not being used with any such meaning or connotation. As evidence of the connotation of the Cited Marks

as used by Registrant, Applicant attached pages from Registrant's website¹, as well as a depiction of the way Registrant uses the mark, which includes a stylized version of a religious cross inside the letter "o." *See* Applicant's Brief. This evidence was not presented to imply that Registrant has any requirement to use the mark with any particular stylization, but instead in order to show the *context* of Registrant's use in order to show the *meaning* that the mark conveys. The meaning of the marks cannot be evaluated out of context. "In determining the meaning and connotation which the trademark projects, it is proper to look to the context of use such as material on labels, packaging, advertising and the like." 3 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS* § 23:26. Here, the connotation on Registrant's website clearly points to a play on words between a street crossing and the religious connotation, with the "cross" portion signifying a Christian religious cross and the term "crosswalk" likely connoting the biblical story of Jesus' walk with the cross.²

Applicant's use of the term clearly has no such similar connotation. "[W]here a word has different meanings in different contexts, even the use of the same word as a mark will not be likely to cause confusion." 3 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS* § 23:28. Thus, the difference in the connotations of the mark, as evidenced by Registrant's website and the use of the mark with the religious cross, is highly relevant and establishes that there is no likelihood of confusion.

¹ The Examiner seems to imply that Applicant simply "believes" www.crosswalk.com to be Registrant's website. However, Registrant used pages from this website to show evidence of use of Cited Mark 2,805,119 in the Statement of Use it submitted to the U.S. Patent and Trademark Office. Unfortunately the pages were illegible when printed and cannot be attached, but copies can be found on the TDR portion of the USPTO website for Registration No. 2,805,119 under the reference to "Specimens." Due to the technical inability to submit a printout of the specimen with this Brief, Applicant respectfully requests that the TDR citation be incorporated by reference and/or that this Honorable Board take judicial notice thereof pursuant to 37 CFR § 2.122(a), TBMP § 712.

² This contention is bolstered by the fact that a portion of Registrant's description for the Cited Marks actually refers specifically to religion and spirituality.

B. THE SERVICES OFFERED UNDER APPLICANT'S MARK ARE COMPLETELY UNRELATED TO THOSE COVERED BY REGISTRANT'S MARKS.

Applicant's data storage and IT consulting and support services are totally unrelated to the services in the Cited Marks -- internet portal, hosting and chat room services. The Examiner's Brief continues to show a failure to understand the significant differences between the services in Applicant's Mark and the Cited Marks. Applicant clearly explained the differences in the services in its Brief and it is unnecessary to restate those specific arguments again, but Applicant must address several points that the Examiner raised for the first time in her Brief. These arguments are based on false premises, are unsupported by the record and, unfortunately, appear to display a fundamental misunderstanding of both the services covered by Applicant's Mark and the Cited Marks.

First, after asserting with no foundation that the services are related, the Examiner states that, "the respective parties provide similar services with regards to the implementation of databases and software applications." There is nothing in the record that either Applicant or Registrant implements databases -- and they do not. The Examiner twists logic to reason that since data storage systems (about which Applicant consults) require databases and Registrant provides databases, therefore Applicant's consulting services regarding data storage systems and Registrant's databases are "complimentary." This is simply unsupported by the record, and strains the identification of the services to the point of breaking. The limited portion of the Cited Mark's identification of services that even includes databases is specifically "providing an online computer database in the field of religion and spirituality." There is no other mention of "databases" in any portion of the Cited Marks' descriptions of services. There is nothing in the record, and it is devoid of logic, to suggest that a large-scale data storage system identified by Applicant's Mark would run on a religion and spirituality database as identified in the Cited

Marks. The reference to a database in the Cited Marks' description most likely relates to a large database of articles and literature regarding religion and spirituality that can be accessed on its website. There is no relationship to data storage systems as in Applicant's description.

The Examiner then states that a consumer who seek a service to "have their data and documents electronically transmitted" (presumably referring to Registrant's services) may need a data storage system. First of all, this is a presumption with no evidence behind it and second it is irrelevant. If someone purchases a book, she might need to buy a lamp to read it with but this does not mean the two items are related, nor that anyone would be confused as to their source.

Finally, contrary to the Examiner's contention, the term "information technology" is not overly broad³ and does not encompass Registrant's offered services. But that isn't even the correct query. Applicant's description of services does not state that it "provides information technology." In relation to that term, and as is stated in its description, Applicant provides "assessment and design of information technology . . . systems for others . . . [and] maintenance of information technology software for others." This is specific and relates to professional services regarding the development of computer systems. These services are worlds away from the provision of internet hosting, temporary use of hosted databases and hosted software and chat rooms.

In sum, the Examiner's latest arguments are largely erroneous and not persuasive. There is no realistic likelihood that a consumer would confuse the source of services as different as Applicant's IT and data storage consulting and maintenance services with the Cited Marks' internet hosting, news and chat room services.

³ "Information technology consultation" in Class 42 is specifically listed as an acceptable description in the online version of the Trademark Acceptable Identification of Goods and Services manual, located on the US Patent and Trademark Office website.

C. THE TRADE CHANNELS FOR APPLICANT'S SERVICES ARE DIFFERENT THAN THOSE FOR SERVICES SOLD UNDER THE CITED MARKS.

The trade channels for Applicant's and the Cited Mark's services are distinct. Relevant trade channels cannot be analyzed in a vacuum. The relevant inquiry is whether the marks "when used in the marketplace, are likely to confuse the purchasing public . . ." *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352 (Fed. Cir. 1992). Thus, the Board need "not be concerned with mere theoretical possibilities of confusion but with the practicalities of the commercial world, with which the trademark laws deal." *Witco Chem. Co. v. Whitfield Chem Co.*, 164 U.S.P.Q. 43, 44-45 (CCPA 1969). The Examiner not only neglected to do this in her analysis of the services, as stated above, but also in her newest arguments regarding the trade channels for the services.

The marketing of the respective services and the trade channels used are so different that a consumer would not be confused as to the source of the services. The Examiner fails to address this properly. The Examiner does not acknowledge that Registrant's services are marketed primarily to religious individuals and organizations. This contention ignores the obvious. The website www.crosswalk.com, on which Registrant offers its services is clearly tailored to consumers seeking services related to the Christian religion and values. The services of internet hosting, news and chat rooms, as well as religious databases are all available to interested consumers on the site. Although they are open for all consumers, it is clear that they are marketed to Christian consumers. This is completely different from Applicant's trade channels. Applicant offers high complex professional services to corporations related to their computer and data storage systems. To obtain them, a consumer does not simply sign up online and start using the services, the way they might with Registrant's databases or chat rooms. Instead, they are marketed in a very involved process directly to high level executives and

information technology professionals. While it is true, as the Examiner notes, that any of these executives or professionals could also be “religious,” in the context of choosing Applicant to do their systems consulting and maintenance they would be carefully evaluating Applicant’s services in terms of the computer systems for their businesses. Thus, because of the vastly different methods by which Applicant and Registrant sell their services, even “religious” consumers would not confuse Applicant’s services with any Christian database or an online chat room or internet portal. Registrant’s services are marketed to individual consumers generally for use in their private lives, whereas Applicant’s services are marketed exclusively to corporations to use as part of their overall information technology and data storage strategy. There is no overlap here. To suggest otherwise strains credulity.

D. APPLICANT’S SOPHISTICATED CUSTOMERS WOULD NOT CONFUSE APPLICANT’S SERVICES WITH REGISTRANT’S.

As established above, the relevant buyer class of Applicant’s services is composed solely of sophisticated, professional purchasers. The Examiner argues in her Brief that the Applicant’s identification is not limited to any particular trade channels or purchasers. While this is true, the Examiner is yet again operating in a vacuum and ignoring important precedent which dictates that the reality of the marketplace in which the marks are used frames the relevant analysis. *See* 3 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS* § 23:101, *citing Castle Oil Corp. v. Castle Energy Corp.*, 26 U.S.P.Q.2d 1481, 1489, 1992 WL 394932 (E.D. Pa. 1992) (“Where, as here, different goods are sold, even if sold under the same mark, to different discriminating purchasers, there is no likelihood of confusion.”). Applicant’s services are highly specialized, expensive and require sophistication to understand how they fit into a corporation’s infrastructure. Purchasing decisions are made by professionals in the field after careful deliberation, thus making any confusion remote. *See Astra Pharmaceutical Products, Inc. v.*

Beckman Instruments, Inc., 718 F.2d 1201, 1206-07 (1st Cir. 1983) (finding no infringement in the case of ASTRA for local anesthetic preparation and ASTRA computerized blood analyzer despite that both sold to “hospital community” where blood analyzers were expensive and purchasing decisions made by sophisticated administrators, and noting that the most important factor in its decision was sophistication of the buyers of the products); *Compaq Computer Corp. v. Procom Tech., Inc.*, 37 U.S.P.Q.2d 1801, 1813 (S.D. Tex. 1995) (“virtually identical” computer drive trays unlikely to be confused where “market consists of sophisticated buyers”). The Examiner cannot simply trot out the stock line that even sophisticated consumers are not immune to source confusion and expect it to be persuasive.

E. LACK OF ACTUAL CONFUSION IS RELEVANT HERE UNDER APPLICABLE CASE LAW

Finally, the Examiner rejects Applicant’s argument that the marks have been in concurrent use without any evidence of actual confusion as “without merit.” Although it is unnecessary to show actual confusion to establish a likelihood of confusion, many courts recognize that a lack of evidence of actual confusion over a period of concurrent use is relevant to the determination of likelihood of confusion in the future. *See* 3 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS* § 23:18.

All of the case law and evidence presented above, which bolsters Applicant’s claim that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks, remains unrefuted and serves as strong support for the registration of Applicant’s CROSSWALK mark.

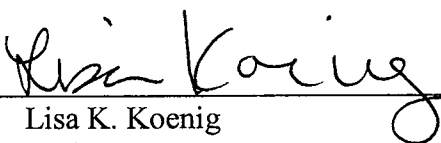
III. CONCLUSION

The Examiner's position that there is a likelihood of confusion between Applicant's Mark and the Cited Marks is in contradiction to clear and precedential case law and the facts. As such, the Lanham Act, case law and the registration practice of the U.S. Patent and Trademark Office supports registration of the Mark.

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Respectfully submitted,

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